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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/828,870

04/20/2004

Michael E. Hirsch

196209 (8287-69US)

5620

23973

7590

04/06/2006

DRINKER BIDDLE & REATH  
ATTN: INTELLECTUAL PROPERTY GROUP  
ONE LOGAN SQUARE  
18TH AND CHERRY STREETS  
PHILADELPHIA, PA 19103-6996

EXAMINER

REHM, ADAM C

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/828,870	HIRSCH ET AL.	
	Examiner	Art Unit	
	Adam C. Rehm	2875	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-19 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 4-7 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/23/06</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by VOLZ (US 5,286,216), which discloses a fluorescent adapter (Fig. 2 generally) comprising:

- A housing (32) including a tip contact (64) compatible with an electrical socket (10) and including a fluorescent ballast (Column 4, Lines 22-34) supported by/contained within the housing (32, Fig. 2);
- A threaded ring contact compatible with the electric socket (36), the ring contact surrounding and secured to the housing (ring 36 surrounds and engages the lower portion of housing 32, Fig. 2) and freely rotatable with and relative to the housing when the housing is rotated in a first direction and not rotatable with the housing when the housing is rotated in an opposite direction (36, Column 4, Line 58-Column 5, Line 17 provides a ring 36 that mates with housing 32 via rotating in a first direction and upon insertion of the housing and ring into the socket 10, the ring 36 is not rotatable with the housing in the opposite direction);

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- Wherein the ballast (32 illustrates a housing enclosing a ballast) has input electrodes/contact pins (86) in electrical contact with the tip contact and the ring contact (Fig. 2), respectively, and output electrodes/key slots (74 being keyed to the contact pins) for removably receiving the contact pins of a fluorescent lamp (80); and
- A drive member integrally molded on the housing for engaging the ring contact when the housing is rotated in the first direction during insertion of the adapter into the socket and for disengaging from the ring contact when the housing is rotated in the opposite direction (62, Fig. 2 illustrated a housing drive member that engages ring 36 via rotation of housing 32 in the first direction during insertion into socket 10 and disengages from ring 36 upon rotation in the opposite direction).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over VOLZ (US 5,286,216) as applied to claim 9 above, and further in view of MATSUBA ET AL. (US 6,736,526). VOLZ discloses the claimed invention, but does not disclose an enclosure removably attached to the ballast for enclosing the fluorescent lamp.

However, MATSUBA teaches a globe (10) for the purpose of providing an improved

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external appearance (Column 2, Lines 31-34). It would have been obvious to one of ordinary skill in the art at the time of invention to modify VOLZ and use the globe as taught by MATSUBA for aesthetic purposes.

***Allowable Subject Matter***

3. Claims 14-19 are allowed.
4. Claims 4-7 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. The following is a statement of reasons for the indication of allowable subject matter: no prior art of record discloses or otherwise suggests a fluorescent adapter as claimed with emphasis on (Claims 4 and 5) at least one tooth for engaging the ring contact; (Claims 6 and 7) a disc having at least one tooth and the ring contact includes at least one opening for receiving the tooth; (Claim 13) a slot in the ring contact with a projection on the housing; (Claim 14) the ballast input electrodes in a bayonet style connection; or (Claims 15-19) a housing including a receptacle to receive input electrodes of a fluorescent ballast and a tip contact compatible with an electric socket and a threaded ring contact.

***Response to Amendment***

6. Applicant's amendment filed 1/23/2006 has been received. The objection to the drawings is withdrawn and the drawings are accepted.

***Response to Arguments***

7. Applicant's arguments filed 1/23/2006 have been fully considered and are partially persuasive.

8. Applicant argues that VOLZ does not disclose the claimed invention because VOLZ instructs users a particular manner of installation. In response, Examiner submits that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As noted above, VOLZ is commensurate with the scope of Applicant's claims.

9. Applicant argues that "VOLZ's device would not provide 'a fluorescent adapted comprising...a housing [and] a threaded ring contact...not rotatable with the housing with the housing is rotated in an opposite direction' because when the housing is rotated in the opposite direction, there is no longer an adapter, but only a collocation of parts." Examiner submits that Applicant does not require that the adapter be rotated and a reasonable interpretation of the claims only require "...a threaded ring contact...rotatable with the housing...". Further, the "adapter" element has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural

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limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

10. Applicant argues that VOLZ does not disclose or suggest an adapter in which the housing rotates in the second direction while remaining assembled to the ring, the ring does not rotate and the assembled housing remains in the socket. As previously noted, VOLZ does disclose an adapter (Fig. 2 generally) in which a housing (32) rotates in the second direction while the ring (36) does not rotate. In regard to an assembled housing remains in the socket, Examiner notes that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

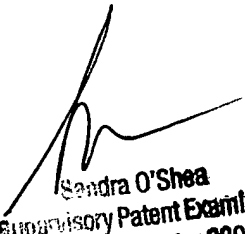
***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam C. Rehm whose telephone number is 571.272.8589. The examiner can normally be reached on M-F 9-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571.272.2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ACR  
3/31/2006

  
Sandra O'Shea  
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